UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,206	11/12/2003	Robert Francis de Sylva		8268

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EXAMINER
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ART UNIT	PAPER NUMBER
2887	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/712,206	DE SYLVA, ROBERT FRANCIS
	Examiner	Art Unit
	Seung H. Lee	2887

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 September 2008*.
2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24 and 45-50* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-24 and 45-50* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of the response filed on September 17, 2008, which has been

entered in the file.

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1-11, 15-24, 45-50 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Mitchell et al. (US 2003/0149661 A1)(hereinafter referred to as

'Mitchell') in view of Waters et al. (US 2002/0147600)(hereinafter referred to as

'Waters').

        Re claims 1, 3-10, 15, 45-50 : Mitchell et al. disclose a payment management

system (100) comprising a charging terminal (EFTPOS terminal in [0002]) for charging

an account based on an account number (credit card/debit card number), a scanner

(fingerprint reader in Fig. 1) for obtaining biometric information (fingerprint), first means

(POS/ATM in [0023]) for employing said biometric information to automatically provide

an account number to said charging terminal, wherein said first means includes means

for automatically selecting based on said biometric information an account from among

plural accounts based on said biometric information ([0017]-[0018] and [0049]), second

means (the fingerprint reader has controls; [0049]) for enabling a user to control which

account number is selected by said first means (MasterCard/Visa/Diner's club, etc.),

wherein said second means includes third means (arrow keys) for enabling a user to

prioritize plural accounts, an available account with the highest priority ([0050]) being

automatically selected by said first means (The user or merchant could prioritize these

account according to some scheme; [0050]-[0051]) wherein said second means

includes software that enables (320 in Fig. 3) a user to trigger automatic selection of an

account based on which type of biometric information or combination of biometric

information that said user provides ([0049]), wherein said system further includes fourth

means for providing transaction information, including amount of said transaction and/or

type of said transaction, to said first means ([0052]), wherein said second means

includes fifth means ([0053]- [0056]) for enabling a user to specify selection rules or

selection criteria based on said transaction information that dictate which account is

selected by said first means based on said transaction information, wherein said first

means includes sixth means (POS terminal will have a card reader to read the magnetic

strip on a credit or debit card, and this information on the customer's account will be

linked to a keypad, on an EFTPOS remote terminal enabling the customer to enter a

PIN f required, and in the case of credit card transaction to push the button marked

"credit" so that the information from the card and the customer's PIN (if required) is

transmitted to a clearing house.) for employing transaction type information to limit

selection of account numbers to only those account numbers that are associated with

accounts that are compatible with said transaction type ([0048]-[0049]), wherein said

first means includes a database ([0018]) that is remotely accessible to a user, said

database including means for authenticating said user before allowing said user to alter selection rules associated with accounts of said user ([00619]-[0021]) ([0007]-[0008] and [0023]- [0024]).

However, Mitchell fails to particularly teach that the terminal is initiating charging transaction.

Waters teaches a system (10) comprising a payment host (20) coupled to a payment device (18) and biometric input device (14) to transmitting acquired biometric data to an identity lookup database (24) and initiating financial transaction in response to the received result from the database by transmitting data to a banking network (30) (see figs. 1-2; paragraphs 0017-0024).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Waters to the teachings of Mitchell in order to provide an improved management system by providing separate identity lookup database for managing each and every biometric data that is link to the particular account information.

Re claim 2, Mitchell et al. disclose the system as recited in rejected claim 1 stated above, wherein said first means is a credit card or Automated Teller Machine (ATM) terminal, and wherein said account number includes a credit number and a corresponding expiration date or an ATM number and a corresponding personal identification number ([0023]-[0024]).

Re claim 11, Mitchell et al. disclose the system as recited in rejected claim 1

stated above, wherein system further includes seventh means (clearing house; ([0051]-

[0052]) for automatically providing transaction information to said charging terminal.

Re claim 16, Mitchell et al. disclose the system as recited in rejected claim 15

stated above, wherein said first means includes means for providing a first signal (good

scan) based on said one or more biological characteristics, said first signal acting as an

authorization signal, an authentication signal, and an account-selection signal, said

second means providing said transaction signal based on said first signal (acceptance)

and wherein said secondmeans (controls along with arrow keys) does not require

participation of a clearing house.

Re claim 17, Mitchell et al. disclose the system as recited in rejected claim 16

stated above, wherein said second means further includes a database ([0017]-[0018])

for selectively outputting account information contained in said transaction signal based

on said first signal.

Re claim 18, Mitchell et al. disclose the system as recited in rejected claim 17

stated above, wherein said database includes an account list, said account list being

user-configurable, thereby enabling a user to selectively control which account is

automatically selected by said second means in response to said first signal (good

scan; [0024]-[0025]).

Re claim 19, Mitchell et al. disclose the System as recited in rejected claim 18

stated above, further including means for identifying a user (biometric reader and

card/check reader; {0033}) before enabling said user to access or configure information that is stored via said database and that is associated with said user.

Re claim 20, Mitchell et al. disclose the system as recited in rejected claim 17 stated above, further including means for enabling a user to predetermine account selection rules for accounts listed in said database, said selection rules determining which account is selected in response to a charge initiated by said system ([0055]).

Re claim 21, Mitchell et al. disclose the system as recited in rejected claim 20 stated above, wherein said means for enabling includes a terminal (EFTPOS Remote in Fig. 1) positioned remotely from a point-of-sale associated with said financial transaction.

Re claim 22, Mitchell et al. disclose the system as recited in rejected claim 19 stated above, further including means for employing said first signal to authenticate (Credit database matching process and a resulting signal from that process) said user before providing said transaction signal to said third means ([0052]).

Re claim 23, Mitchell et al. disclose the system as recited in rejected claim 22 stated above, wherein said second means includes means for storing information pertaining to said one or more biological characteristics of a user when said means for employing fails to authenticate said user ([0051]),

Re claim 24, Mitchell et al. disclose the system as recited in rejected claim 15 stated above, wherein said third means ([0052]) includes a credit card, charge card, and/or Automated Teller Machine (ATM) charging module, and wherein said transaction

signal includes a selected credit card, charge card, or ATM card number associated

with said user and any relevant pins or dates ([0052]).

3.   Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Mitchell as modified by Waters as applied to claim 1 above, and further in view of Kipp

(US 5,239,167).

Re claims 12-1.4, the teachings of Mitchell/Waters have been fully discussed

with the exception of means for wirelessly interrogating product tags associated with

products to be purchased, price information and deactivation process.

Kipp discloses a checkout system that uses radio frequency tags. An article 12 is

associated with a respective transmitter means 20 for transmitting product-identifying

data upon actuation and then deactuating itself. The transmitter 20 may be in the form

of a tag associated with the article and securely attached thereto to prevent accidental

separation. Examples of product-identifying data may be a product price, volume or

weight of the product. One the tag successfully transmits all of the product identifying

data (26), it reads an erase signal which causes deactuation of the signal trigger (24) so

that the transmitter is inactivated. Once the transmitter of this article turns itself off, the

remaining articles 12 in a container 10 will be read in turn in a sequence determined by

the receipt by the receiver in the checkout area 14. The system allows a faster and

accurate retail transactions with a minimum supervision of a store clerk or a manager.

In view of Kipp's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further employ a checkout system for conducting an operator-unassisted checkout in addition to the payment management system of Mitchell/Waters for the purposes of minimizing manpower in a retail environment while increasing checkout speed without compromising the accuracy of the retail transactions.

Response to Arguments

4.   Applicant's arguments filed September 17, 2008 have been fully considered but they are not persuasive.

In response to applicant argument that "...neither Waters nor Mitchell disclose, or suggest the first means as recited in claim 1 and certainly neither Waters nor Mitchell teach provide an account number to a POS for the purposes of charging the account number via a POS or other preexisting infrastructure....not to initiate a charge via the payment device....(see page 10, paragraphs 5+), the examiner respectfully disagrees with the applicant wherein Mitchell teaches an EFTPOS terminal for charging account number that is corresponding to fingerprint and Water teaches the payment device for initiating financial transaction as discussed above.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., claims does not need to implementing a clearing house or merchant payment host, etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light

of the specification, limitations from the specification are not read into the claims. See

In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that "…the databases of Mitchell and Waters

are not user modifiable…" (see page 11, paragraph 4+), the examiner respectfully

disagrees with the applicant wherein Mitchell teaches selecting means for selecting

particular account according to biometric information as discussed above.

In response to applicant's argument that "…the position that the payment device

of Water initiates a financial transaction by transmitting data received from a database

to banking network is in error…" (see page 12, paragraph 5+), the examiner respectfully

disagrees with the applicant wherein the payment transaction starts at the POS terminal

having a payment device. As applicant stated the payment device providing biometric

information and authorization information to a host for transaction authentication, such

transmitting information is considered as initiating the charging transaction.

In response to the applicant argument that "..Water does not teach use of a

separate database..." (see page 14, paragraph 1+), the examiner respectfully disagrees

with the applicant wherein Waters teaches a lookup database to stored biometric

information as discussed above.

In response to applicant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., retrieval of a PIN) are not recited in the rejected claim(s). Although the claims are

interpreted in light of the specification, limitations from the specification are not read into

the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

5.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Seung H. Lee whose telephone number is (571) 272-

2401. The examiner can normally be reached on Monday-Friday, 7:30 AM- 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Steven S. Paik can be reached on (571) 272-2404. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Seung H Lee/
Primary Examiner, Art Unit 2887

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